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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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QM12/0315  
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EXAMINER

GORSKI, J

ART UNIT

PAPER NUMBER

3726

DATE MAILED:

03/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

627270

Applicant(s)

TOSO et al.

Examiner

GORSKI

Group Art Unit

3726

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 12/20/99

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 14-16, 19, 20, 26, 27 and 30-42 is/are pending in the application.

Of the above claim(s) 14-16, 19 and 34-36 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 20, 26, 27, 30-33 and 37 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claim(s) 14-16, 19 and 34-36 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit:

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 20 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Swidler "436.

Applicant is referred to the corresponding paragraphs of the Office Action mailed June 7, 1999, paper number 17.

Regarding this rejection, Applicant argues that the full disclosure of Swidler teaches away from applying a strippable paint to a painted surface of an automobile prior to mounting of an engine and functional parts to the automobile in an assembly process because, Swidler's full disclosure of his actual invention has nothing to do with vehicle assembly. However, Swidler's failure to particularly address using the coating during an assembly process, per se, does not establish that Swidler teaches away from Applicant's claimed invention. Were Swidler to express that an anti-scratch cover is used during the assembly process, then it could be said that Swidler teaches away from the claimed invention.

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The main issue to be addressed in determining whether Applicant's claimed invention is anticipated or obvious in view of Swidler should **not** be what Swidler fails to disclose, but rather should be what one having ordinary skill in the art would have gleaned from this reference "as a whole".

Accordingly, column 1, lines 11-14 of Swidler establish that the surface paint finishes of new vehicles are subject to injuries both during the assembly process and during transportation from the assembly plant to other locations. Next, column 1, lines 39-44 establish that plastic or canvas covers have been used to protect the surface paint finishes of new vehicles during the manufacturing and transportation thereof. Then, Swidler explains how his coating can be used in place of these covers during the transportation of the vehicle from the assembly plant to other locations. Thus, a logical inference that one would draw from Swidler is that his coating can be substituted for the plastic and vinyl covers wherever they have been used in the past.

Accordingly, Swidler inferentially teaches that his coating is applied to the vehicle during the assembly process, whereby claim 20 is anticipated by this reference. Alternatively, from the aforementioned inference one having ordinary skill in the art would have found it obvious to apply the coating prior to performing assembling or manufacturing operations, whereby claim 20 is obvious.

The **main** focus of Swidler is the general protection of surface paint finishes of new vehicles, and **not** merely protection following manufacture. In this regard, column 5, lines 8-36 discuss the general method of protecting surfaces without limiting it to any time frame relative to

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the manufacture of the vehicle. Then, column 5, lines 37-39 state that the invention **further** includes a method of transporting the protected vehicles. Thus, Applicant's statement, that Swidler's invention is only discussed in terms of preventing damage to paint finished surfaces of the vehicle subsequent to vehicle manufacture, fails to consider the reference "as a whole".

4. Claims 20, 26, 27, 30-33 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art as described on pages 20-21 of the specification in view of Swidler and the state of the art.

On pages 20-21, Applicant discloses to be prior art the use of an anti-scratch cover during the manufacture of a vehicle. Swidler discloses that a strippable paint can be used in place of an anti-scratch cover. In view of Swidler, one having ordinary skill in the art would have found it obvious to use a strippable paint in place of the anti-scratch cover of Applicant's admitted prior art, in order to realize the benefits thereof.

The subject matter of claim 26 would have been obvious to one having ordinary skill in the art because, it is state of the art to perform a step of finished product inspection following an assembly step. Regarding the remaining claims, the subject matter thereof is held to be matters of engineering design choice.

5. Claims 20, 26, 27, 30-33 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swidler '436 and the state of the art.

The subject matter of claim 26 would have been obvious to one having ordinary skill in the art because, it is state of the art to perform a step of finished product inspection following an

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assembly step. Regarding the remaining claims, the subject matter thereof is held to be matters of engineering design choice.

6. Applicant takes issue with the examiner's "design choice" rejections of certain claims. However, inasmuch as the significance of the subject matter of these claims is not clear from Applicant's disclosure, the "design choice" rejections are proper. In this regard, in order for the examiner to determine the patentable significance of claim limitations the significance of these limitations must be understood by the examiner. Similarly, in order for the examiner to conduct an appropriate search with regard to these limitations the significance of these limitations must be understood by the examiner.

The significance of claims 27, 30-33 and 37-42 appear to be directly related to the composition of the strippable paint. Yet, this composition is not disclosed in the specification. Accordingly, in order to aid the examiner in performing his duties, the following questions are posed to Applicant:

What is the composition of "Lapguard", mentioned on page 13 of Applicant's specification?

What are known techniques of stabilizing "Lapguard"?

What are known techniques of drying "Lapguard"?

7. The rejections contained in the Examiner's Answer are hereby withdrawn and replaced by the following rejection.

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8. Claims 20, 26, 27, 30-33 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art contained on pages 20-21 of the specification in view of Applicant's admitted prior art contained on page 2, lines 7-8 of the specification..

On pages 20-21 of the specification it is disclosed to be conventional to assemble an automobile after its individual parts have been painted, wherein an anti-scratch cover protects the these parts during the assembly process.

On page 2, lines 7-8 of the specification it is disclosed to be conventional to coat small parts with a strippable paint for protection. These parts are presumed to be assembled to other parts after they have been coated, wherein the strippable paint protects these parts during this assembling.

Accordingly, in view of this prior art one having ordinary skill in the art would have found it obvious to substitute a strippable paint for the anti-scratch cover in order to realize the benefits that the strippable paint exhibits relative to the anti-scratch cover.

The remaining claims would have been obvious for reasons as expressed supra.

The examiner appreciates that this rejection is based on a presumption which has not been proven by the examiner. Accordingly, for the third time, Applicant is requested to address the following question.

Are the small parts referenced on page 2, lines 7-8 of the specification, assembled with other parts after these small parts have been coated with the strippable paint?

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9. The above rejections are repeated, and apply the additional teaching of Langerbeins et al. Should it be determined that the strippable paint must be sufficient to protect the paint finish from injury that is unique to the assembly process, e.g. scratching from tools, etc., and not merely sufficient to protect the surface from dust or debris; and along with this determination, should it be determined that the aforementioned references fail to at least suggest that the strippable paint thereof is capable of protecting the paint finish from such assembly process injuries; then in view of Langerbeins et al's teaching at column 1, lines 14-16, one would have found it obvious to use the coatings of the aforementioned references to protect the surface of the parts during the assembly thereof.
10. Any inquiry concerning this communication should be directed to Joseph Gorski at telephone number (703) 308-1805.

  
**Joseph M. Gorski**  
**Primary Examiner**